

REMARKS

This paper is submitted in response to the Office Action mailed September 24, 2003.

Upon entry of this Amendment, claims 1-7, 9-12, 16-18, 21-31 are pending. Claims 29-31 have been added. Support for the new claims may be found throughout the specification and claims as discussed below. Since support for the amendments and new claims can be found throughout the specification and claims as originally filed, there is no new matter added as a consequence of the amendments and new claims.

The Rejections under 35 U.S.C. § 103(a) Should Be Withdrawn

Claims 1-3, 6, 7, 9-12, 16, 17, and 21-28 have been rejected under U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,311,700 to Thomas in view of Netherlands Patent NL 8700470 to Dekker. The Examiner alleges that Thomas teaches a method of manufacturing a plant support manufactured having an at least partially covered open wall, the box-shaped element being at least partially covered with a preferably substantially biodegradable covering material, the covering material being provided in such a manner that it covers the partially open wall at least partially, such that the wall becomes soil proof, while roots of a plant, growing in a pot during use, can grow at least partially through the covering material and the wall to the outside of the plant support, characterized in that as covering material a material that is manufactured from biodegradable material. The Examiner acknowledges that Thomas is silent on the substantially vertical extending guide element mounted on the box-shaped element. However, the Examiner alleges that Dekker teaches a substantially vertical extending guide element mounted in combination on a box-shaped element. The Examiner also alleges that it

would have been obvious to the skilled artisan to modify the teachings at the time of the invention since it is old and notoriously well known in the art of plant husbandry to provide a vertical support for plant to control the shape of the plant and to prevent the plant from bending and resulting in damage to the plant stem. With regard to claims 2, 3, 17, 22, 23, 24, 25 and 28, the Examiner alleges that Thomas as modified teaches the recited claim limitations of each claim. With regard to claims 7, 21, and 27, the Examiner alleges that the recited claim limitation is known in the art.

Claims 4, 5 and 18 have been rejected under U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,311,700 to Thomas in view of Netherlands Patent NL 8700470 to Dekker as applied to claim 1, and further in view of U.S. Patent No. 3,958,365 to Proctor. The Examiner alleges that Thomas as modified teaches a polyurethane liner, but acknowledges that it is silent on the covering material being made from at least natural fibers and binding agent. The Examiner alleges that Proctor teaches a wire basket liner made of coco fiber and latex and is a polymer liner. The Examiner further alleges that it would have been obvious to the skilled artisan to modify the liner of Thomas with the natural fibers of Proctor for the efficient means of conserving moisture in the soil which plants grow, since the modification is allegedly an alternate plastic/polymer liner that contains soil and permits growth of roots through the liner.

Applicant respectfully disagrees. To establish a *prima facie* case of obviousness, three basic criteria must be met (MPEP 2142). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the teachings. Second, there must be a

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1981).

Applicant submits that there is no suggestion or motivation provided in Thomas to modify the disclosed container for plants. Thomas teaches a wire basket with a polyurethane liner for growing and holding trees for the purpose of transplantation. During use above ground, growth medium, such as earth, is placed in the liner and roots may penetrate the liner to facilitate air pruning. As acknowledged by the Examiner, Thomas fails to disclose the substantially vertical extending guide element mounted on the box-shaped element. However, Thomas discloses only the use of the container for trees, which are entirely self-supporting plants, having no need for any type of support in the disclosed container. Therefore, the skilled artisan, upon a reading of Thomas, would not seek to modify the disclosure to incorporate a vertical guide element into the disclosed plant container to support plant growth.

Applicant also submits that there is no suggestion or motivation provided in Thomas to combine its teachings with any other references, either Dekker or Proctor. Without a teaching or suggestion of a need to modify Thomas, there is no suggestion or motivation to look for another reference to combine the cited references in either reference so as to arrive at the claimed invention.

Furthermore, applicant disagrees with the Examiner's contention that it would have been obvious to one of ordinary skill in the art to modify the teaching of Thomas at the time of the

invention, since it is old and notoriously well known in the art of plant husbandry to provide vertical support for plant. In fact, Thomas teaches away from the use of any support since Thomas only discloses trees.

Since applicant submits that in the absence of some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify Thomas or to combine the disclosure of Thomas with Dekker or Proctor, there is no reasonable expectation of success that the combination would produce the presently claimed invention.

Lastly, applicant submits that Thomas fails to teach or suggest all claim limitations. Specifically, the presently claimed plant support comprises a box shaped element being at least partially covered with a substantially biodegradable covering material. Thomas does not cite the use of “substantially biodegradable covering material.” The Examiner has cited the liner (structure #44) of Thomas as functionally equivalent to the presently disclosed “substantially biodegradable covering material” (Office Action, page 2, para. 3). According to Thomas, the liner is made of polyurethane and should be reasonably *non-biodegradable*, thereby teaching away from the present invention (specification, col. 2, lines 23-24; col. 4, lines 19-26; col. 4, line 15). Thomas requires that the liner be made of a non-degradable material to avoid rot, while the plant is stored above ground, which is in direct conflict with the present invention. In alternative embodiments of the invention, the use of natural materials are also discouraged (specification, col. 5, lines 10-23). Therefore, Thomas fails to disclose each and every limitation of the presently claimed invention. Since Dekker also does not appear to disclose “substantially

biodegradable covering material,” its combination with Thomas would not cure the deficiency of Thomas.

With regard to Proctor, the Examiner points out that Proctor teaches a wire basket liner made of coco fibers and latex and that the liner of Proctor is made of polymer liner, and alleges that it would have been obvious to one of skill in the art to modify the liner teachings of Thomas with the natural fiber teachings of Proctor for the efficient means of conserving moisture. The Examiner alleges that the modification is merely an alternate plastic/polymer liner that contains soil and permits growth of the roots through the liner. Proctor requires that the natural fibers be coated with an adhesive bonding agent or plastic material, such as rubber or latex, to enable the molding of the materials into particular shapes and for water-proofing purposes (Proctor specification, col. 1, lines 47-59; col. 2, lines 38-43). This type of coating on the fibers would cause the fiber not to be “substantially biodegradable.” The combination of Thomas and Proctor would result in the wire basket of Thomas, having a liner comprising the natural fibers coated with synthetic *non-biodegradable* materials. Therefore, Proctor also does not disclose “substantially biodegradable covering material,” and its combination with Thomas would not cure the deficiency of Thomas.

With regard to claims 7, it is respectfully submitted that weaving the support into the wire creates the advantage of better retention in place when the plant support is filled with earth.

With regard to claims 22 and 23, applicant submits that neither Thomas nor Dekker discloses a demountable guide element. Figure 4 of Dekker shown as a single continuous piece, which is an elongation of one side of the box-shaped element. Therefore, there is no teaching in either Thomas or Dekker for a demountable guide element.

With regard to claim 25, applicant submits that neither Thomas nor Dekker discloses a guide element having one or more a plants on *both* sides of the vertically extending guide element of the box-shaped element. Dekker discloses plants only on one side of a vertical guide element that may be positioned “back to back” with another vertical guide element. However, it clearly fails to teach all claim limitations recited in claim 25.

For all the foregoing reasons, applicant submits that claims 1-6, 7, 9-12, 16, 17, 18 and 21-28 are patentable over Thomas in view of Dekker and further in view of Proctor. Applicant respectfully requests withdrawal of the rejection of the claims under 35 U.S.C. § 103(a).

New Claims

Claims 29-31 have been added. Support for the claims can be found throughout the specification and claims as filed and, in particular, at page 5, lines 8-10, page 10, line 28 to page 11, line 1, and page 11, lines 2-4. Applicants submit that the new claims are also patentable over the cited art discussed herein.

Response to Examiner’s comments on Cahill (U.S. 994,816)

The Examiner alleges that Cahill (U.S. 994,816) teaches that the wire basket is planted in the ground. Applicant respectfully disagrees.

Cahill discloses that the container must be set in a low, wet place in the yard when the soil is soft, so that the soil and moisture will work up through the bottom of the basket to facilitate which open places should be left in the bottom of the basket (page 1, line 100-105).

The suggestion is that the bottom of the basket will come into contact with the soil in order for

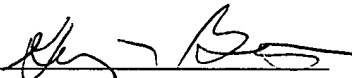
the soil to go up into the bottom. However, there is no indication that the soil should also make contact with the sides of the basket. The term, "at final planting," should be construed to mean that the plant remains in the basket as it is placed in its final place. The basket is not meant to be inserted into another container or the ground. Furthermore, vines can be planted so that they show through the sides of the basket for an aesthetic effect (col. 2, lines 91-93). If the basket were to be inserted into the ground, such plantings would be unnecessary since these vines would be smothered in the ground.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request withdrawal of the outstanding rejections and allowance of the pending claims.

Applicants request a three month extension of time and enclose herewith the requisite fee as set forth in 37 C.F.R. § 1.17(a)(3). Applicants do not believe that any additional fee is required in connection with the submission of this document. However, should any fee be required, or if any overpayment has been made, the Commissioner is hereby authorized to charge any fees, or credit or any overpayments made, to Deposit Account 02-4377. A duplicate copy of this sheet is enclosed.

Respectfully submitted,
BAKER BOTTS L.L.P.

By: 
Gary M. Butter
Patent Office Reg. No. 33,841

Dana Lau
Patent Office Reg. No. 55,361

30 Rockefeller Plaza
New York, NY 10012-4498
(212)-408-2500